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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,059	01/19/2000	TATSUYA NAKANO	2224-163P	5816

2292 7590 02/28/2003

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EXAMINER

THORNTON, YVETTE C

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/28/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/463,059

Applicant(s)

NAKANO, TATSUYA

Examin r

Yvette C. Thornton

Art Unit

1752

--The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the \_\_\_\_\_ application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,2,8-10 and 12-14.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: the claims were amended to include the limitations of instant 7 and to simplify the choices for the oxygen-containing group represented by R4. The said amendment however fails to overcome the art of record. Aoi teaches specific examples of repeating units represented by formula (XXII)-(XIV) to include compound a3, a10, a19 and a20. It is the examiner's position, as set forth in the previous action, that formula a19 and a20 meet the limitations of instant claim 1 and formula a3 and a10 meet the limitations of claim 9. Although Aoi fails to exemplify a compound having an oxygen containing substituent off the polycyclic ring. Aoi clearly that preferred substituents of the polycyclic type alicyclic group includes a hydroxyl group and an alkoxy group having 1-8 carbon atoms. It is the examiner's position that one of ordinary skill in the art would have been motivated by the teachings of Aoi to make the taught polycyclic type resin (B) any of the disclosed structure such as a3, a10, a19 and a20 which are substituted with the preferred substituent including a hydroxyl group or an alkoxy group having 1-8 carbons. Applicants argue that the prior art fails to specifically teach the substituent being at a bridgehead position of the alicyclic ring. The examiner is of the position that in regard to formula a20, there are 9 possible substitution positions, 4 of which are bridgehead. One of ordinary skill in the art could readily envision an alicyclic substitution at the bridgehead positions. Furthermore, applicants argue that the present invention provides unexpected results. The examiner has failed to find any evidence in declaration form to support such a finding. The rejection of record is hereby maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

**Please note that the examiner has recently changed her name from "Clarke" to "Thornton".**



ROSEMARY ASHTON  
PRIMARY EXAMINER

401  
2/26/03